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25 SEP 2007

Michael R. Gilman  
Kaplan Gilman Gibson & Dernier LLP  
900 Route 9 North  
Woodbridge, New Jersey 07096

In re Application of :  
HOLDER et al. :  
U.S. Application No. 10/586,782 :  
PCT No.: PCT/GB05/00227 : DECISION ON REQUEST  
Int. Filing Date: 21 January 2005 :  
Priority Date: 21 January 2004 :  
Attorney Docket No.: 642/07.01 :  
For: FILLING MATERIAL

This decision is issued in response to the applicant's petition under 37 C.F.R. §1.47(a) filed 13 July 2007.

**BACKGROUND**

On 21 January 2005, applicant filed international application PCT/GB05/00227 which claimed priority to an earlier application filed 21 January 2004. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 04 August 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 July 2006.

On 21 July 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee ; a copy of the international application; and a preliminary amendment.

On 19 April 2007, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response.

On 13 July 2007, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventor David Holder.

## DISCUSSION

Applicant is advised that 37 CFR 1.47 applies only where a **known** legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make the application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)). In the present case, for the reasons detailed in the petition and supporting papers, applicant has not provided any information regarding the deceased inventor's legal representative. As such, the petition under 37 CFR 1.47 to accept the application without the legal representative is inappropriate pursuant to MPEP 409.03(c). Applicant's exhibit letter of 27 June 2007 from Mark Goodwin states that "no officer who is authorized to administer Mr. Holder's estate..." If the estate of the deceased inventor was not represented by a legal representative, all of the heirs should have been clearly identified in the declaration. The legal representative of a deceased inventor (or all of the heirs where there was no legal representative) must make the application for patent "on the same terms and conditions applicable to the inventor." (See 35 U.S.C. 117.) In order to proceed under 35 U.S.C. 371, applicant must seek Mr. Holder's current legal representative or all his heirs. Where there is no legal representative to the estate, any court of competent jurisdiction should appoint the legal representative for the sole purpose of prosecuting the application.

In a similar vein, the filed declaration does not comply with 37 CFR 1.497(a)-(b) in that no information has been provided on the declaration for the legal representative or heir(s). The filed declaration lists Mr. Holder with his signature block left unsigned leaving the impression that he is refusing to execute the declaration rather than the fact that he is deceased.

37 CFR 1.42 When the Inventor is Dead, states, in part:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

In order to proceed under 37 CFR 1.47(a), applicant is required to identify the non-signing party, i.e. the legal representative as detailed above. 37 CFR 1.497(b) requires that the declaration identify and provide the citizenship for both the deceased inventor and the legal representative. Accordingly, the petition under 37 CFR 1.47(a) is dismissed.

## CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

A proper submission under 37 CFR 1.42 as discussed above must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any response should include a

cover letter entitled "Submission Under 37 CFR 1.42." No additional petition fee is required.

A proper response must include a declaration in compliance with 37 CFR 1.497(a) and (b) executed by the legal representative of the deceased (or all of the heirs, if appropriate); or, if all of the required signatures cannot be obtained, a proper response must include a grantable petition under 37 CFR 1.47(a). See MPEP 409.01- 409.03(h). Of course, a grantable petition under 37 CFR 1.47 requires, a sufficient showing to accord status under 37 CFR 1.42 including a declaration identifying the non-signing legal representative (or all of the heirs, if appropriate, and the signatures of any available heirs on behalf of themselves and the non-signing heir(s)) together with the other requirements of 37 CFR 1.47.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298  
Fax: (571) 273-0459